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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Michael Reed et al.

Application No.: 08/113,955

Confirmation No.: 3543

Filed: August 31, 1993

Art Unit:

For: MULTIMEDIA SEARCH SYSTEM

Petitions Examiner: David Bucci

**REQUEST FOR RECONSIDERATION/PETITION FOR SUPERVISORY REVIEW OF  
DECISION DENYING PETITION FOR A FILING DATE**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The decision mailed by the USPTO on March 4, 2009 ("2009 Decision") denying Applicant's Request for a filing date to be accorded to the above-captioned application included a footnote on page 12 to the effect that the Decision may be viewed as a final agency decision for purposes of seeking judicial review.

In the Notice to PTO Regarding Decision Denying Petition for a Filing Date, filed March 12, 2009, Applicant indicated that, after a close review of the 2009 Decision, Applicant is of the opinion that the USPTO did not treat the record before it in a manner consistent with the statute, USPTO regulations, or the policy of the USPTO and that Petitioner would present additional evidence in the form of a Declaration from a prior USPTO official (Mr. Jeffrey V. Nase) which will reinforce the

view that the USPTO is incorrectly refusing to grant a filing date in the present application. Now comes this Request for Reconsideration/Petition for Supervisory Review, which Request/Petition is being filed within the two month period provided under 37 C.F.R. § 1.181(f).

This Request/Petition is based upon the following errors committed by the USPTO in:

- (a) initially not according a filing date to this application when it was filed August 31, 1993, based upon a fatally flawed policy that was disavowed by the USPTO on July 22, 1996;
- (b) inconsistently not according a filing date, even based upon its flawed policy and violating its own stated procedure, when it dismissed on February 16, 1994, a petition grantable on its face, that requested the August 31, 1993 filing date, by improperly making the filing date grant contingent upon the filing of a supplemental oath or declaration, which condition was in direct violation of the applicable statute, regulation and the USPTO's own stated procedure;
- (c) continuing to rely upon that flawed, disavowed procedure in maintaining the refusal to grant this application a filing date;
- (d) continuing to refuse to remedy the improper failure to grant a filing date by failing to acknowledge the USPTO's numerous positive, documented, official acts that caused or contributed to Applicant's failure to appreciate that further action was in any way required in this application.

**A. ARGUMENTS AS TO WHY THIS APPLICATION WAS, AND STILL IS, ENTITLED TO THE AUGUST 31, 1993 FILING DATE**

**1. Application Was Entitled to Filing Date Under the Statute and Regulations**

The 2009 Decision of the USPTO indicated that, as this application was deposited with the USPTO on August 31, 1993, the statutes, rules, and procedures in effect at the time of the deposit of the application control and that Petitioner cannot rely upon later promulgated statutes, rules, and procedures to support his assertions that a filing date of August 31, 1993 be granted to the instant application. The 2009 Decision cites 35 U.S.C. § 111 and 37 C.F.R. § 1.53(b) and 1.53(d) in support of the statute and rule in effect at the time of the filing of this application.

What the 2009 Decision fails to appreciate, however, is that this application was (and continues to be) entitled to a filing date under that same statute and regulation. It was only due to the USPTO's clearly erroneous procedure that a filing date was not granted. However, as the record below shows, by July 22, 1996, the USPTO had replaced that flawed procedure.

As set out in 35 U.S.C. § 111 and 37 C.F.R. § 1.53(b) (in effect August 31, 1993), a filing date will be accorded an application which includes a specification as prescribed by 35 U.S.C. § 112, at least one claim, and any drawing required by 37 C.F.R. § 1.81(a). This application, as filed on August 31, 1993, did in fact meet the requirements of the statute and rule for the granting of a filing date for this application in that it included a specification, at least one claim and drawings. In support of Applicants' position that this application is entitled to the requested August 31, 1993 filing date, then and now, Petitioner proffers herewith the Declaration of Mr. Jeffrey Nase, who was the Director of the Office of Petitions in 1993 and in 1994 became the Patent Legal Administrator and whose duties included Rulemaking, Official Gazette Notices and Patentability Guidelines; deciding petitions, including filing date petitions, that came under the authority of the Deputy Assistant Commissioner for Patent Policy & Projects; and special projects.

In his Declaration, Mr. Nase states that the USPTO changed its procedures relating to the treatment of *prima facie* incomplete applications effective July 22, 1996. In this regard, prior to July 22, 1996, the USPTO chose to treat applications filed without all pages of the specification as incomplete and did not accord, as a matter of policy, and notwithstanding 35 U.S.C. § 111 and 37 C.F.R. § 1.53(b), such applications a filing date ("the old missing page procedure"). The change in procedure effective July 22, 1996 treated applications filed without all pages of the specification as complete and accorded such applications a filing date ("the new missing page procedure"). Mr. Nase states that he undertook a review of all filing date procedures for handling pages omitted from an application filed under 37 C.F.R. § 1.53 and from that review concluded that there was no requirement in the statutes or regulations that an application filed under 37 C.F.R. § 1.53 include sequentially numbered pages, or all of the pages to obtain a filing date. Further, Mr. Nase notes in his Declaration that the Implemented Filing Date Notice (at 61 FR 30045) stated that the adopted procedure replaces "formalistic procedures with procedures based upon the requirements for a filing date as set forth in 35 U.S.C. §§ 111, 112, and 113." Therefore, as the procedures in place at the time of deposit of this application were merely "formalistic procedures" and not a requirement of either the statute (35 U.S.C. § 111) or the applicable rule (37 C.F.R. § 1.53(b)), Mr. Nase states that it is his opinion that the instant application was entitled to the August 31, 1993 filing date under the statutes and regulations *in effect at that time*.

Mr. Nase's Declaration further states that the Proposed Filing Date Notice (at 60 FR 56984) indicated that, due to the effect that the loss of a filing date can have on an application, the USPTO generally treats untimely filing date petitions on their merits since the application, as formalistically declared incomplete, will have undergone no further processing or examination. Applicant has no intention of further prosecuting the present application and is in fact authorizing the PTO to expressly abandon it once a filing date is formally accorded the present application. The present Petition is filed simply to perfect subsequent continuing applications which relied under 35 U.S.C. § 120 on the filing date of the present application. Applicant, the general public and indeed the USPTO were completely unaware of this imperfection until the issue was brought to light by an

opposer to Applicant's continuing application(s) in recent litigation. The PTO is well aware of many instances where an oversight goes undetected for many years until it is brought to light. Given that the grant of a filing date simply to cure an oversight relative to a formalistic requirement does not yield a windfall to applicants the way continued prosecution of that same application would, the PTO has historically considered filing date petitions of this type on their merits, even when their filing was delayed due to a lack of awareness that a problem existed. This PTO policy of treating untimely submitted filing date petitions on their merits was publicly announced in the above-noted Proposed Filing Date Notice (at 60 FR 56984).

The failure of the USPTO to grant filing dates in applications with a missing page but which otherwise included the specification, at least one claim and drawings, *was in direct contradiction to the statute and rule in effect at the time of filing*. This contradiction in policy with the statute and rule was recognized by the July 22, 1996 change in the manner in which applications with a missing page of the specification were handled. In this regard, the USPTO in its policy decision of July 22, 1996 disavowed the very practice that is still being unfairly applied to refuse the petition for a filing date in this application. The USPTO recognized that withholding a filing date merely because of the simple absence of a page or pages to the specification was inconsistent and clearly erroneous as a matter of law with the patent statute and rules then (and even now) in effect. The fact that the USPTO misapplied the statute, rule and procedures is clearly supported in comment (11) in the July 22, 1996 Change in Procedure Relating to an Application Filing Date, where members of the public suggested that the proposed procedure be adopted by rulemaking and also suggested that the proposed procedure either be adopted by rulemaking or clearly set forth in the MPEP, the following response is noted:

37 CFR 1.53(b)(2) provides that the "filing date of an application for patent filed under this section, except for a provisional application, is the date on which a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41." \* \* \* **Thus, no change to the rules of practice is necessary to adopt the procedure set forth in this notice [emphasis added].**

As noted by Mr. Nase's Declaration, 35 U.S.C. § 111 provided that "[t]he filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office." Further, 37 C.F.R. § 1.53(b) provided that "[t]he filing date of an application for patent filed under this section is the date on which: (1) a specification containing a description pursuant to 37 CFR § 1.71 and at least one claim pursuant to 37 CFR § 1.75; and (2) any drawing required by 37 CFR § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by 37 CFR § 1.41." Mr. Nase's Declaration notes that, in this application, the USPTO did in fact receive 20 pages of drawings and 68 pages of the specification, including the claims. The 68 pages of the specification consisted of an unnumbered title page followed by 67 pages numbered 2-68. The 68 pages of the specification contained a description pursuant to 37 C.F.R. § 1.71 and at least one claim pursuant to 37 C.F.R. § 1.75. The 20 pages of drawings contained the drawings required by 37 C.F.R. § 1.81(a). The unnumbered title page set forth the names of the actual inventors as required by 37 C.F.R. § 1.41. However, as pointed out in Mr. Nase's Declaration, at the time of filing this application, there was no requirement that the first page of the specification be numbered and it was common for a first page of a document to be unnumbered even when the subsequent pages were numbered. In addition, 37 C.F.R. §§ 1.72(a) and 1.77 together permit the title of the invention to appear as a heading on the first page of the specification if it does not otherwise appear at the beginning of the application and that such title page may also state the name, citizenship, and residence of the applicant. Since a title page is considered to be part of the specification, it is Mr. Nase's expert opinion that this application, as filed on August 31, 1993, was not *prima facie* incomplete by omitting a page numbered 1. Further, although page 2 started in mid-sentence, this was a minor error correctable by a suitable amendment to that page.

2. October 29, 1993 Petition Was Grantable on its Face

Even though the USPTO erroneously maintains that this application was not entitled to the August 31, 1993 filing date for being incomplete by omitting a page numbered 1 and having page numbered 2 start in mid-sentence, the 2009 Decision further overlooks the fact that the former

missing page procedure in effect at the time should have resulted in the grant of a filing date. In that instance, as explained in Mr. Nase's Declaration, Applicants' October 29, 1993 petition under 37 C.F.R. §§ 1.53 and 1.182 for a filing date of August 31, 1993 was grantable at the time of filing thereof since the requirements of the old missing page procedure had been complied with. More specifically, the petition under 37 C.F.R. §§ 1.53 and 1.182 was accompanied by the \$130 fee and an amendment cancelling from the specification all incomplete sentences and renumbering the pages in consecutive order. The petition noted that no claims depended upon missing page 1 for disclosure and support. The petition also included a statement that the invention is adequately disclosed in, and that Applicants wish to rely on, the application as amended without the missing items and the references thereto in the specification, for purposes of an original disclosure and filing date. The sole reason the USPTO dismissed the petition under 37 C.F.R. §§ 1.53 and 1.182 was because a supplemental declaration from the inventors stating their intention to rely on the application without page 1 had not been submitted.

3. Requirement of Another Declaration Was Inconsistent with Statute and Regulations

Petitioner contends that the petition for filing date filed in this application on October 29, 1993 in reply to the September 14, 1993 Notice of Incomplete Application, did in fact, comply with the requirements for a filing date and, therefore, the USPTO erred in not granting a filing date of August 31, 1993 to this application. In this regard, the Notice of Incomplete Application of September 14, 1993, indicated that page 1 of the specification was missing and, as one option for a filing date, stated that a petition could be filed stating that the missing item was not necessary for a filing date. The Notice of Incomplete Application mailed by the USPTO on September 14, 1993 was also accompanied by a Notice to File Missing Parts of Application – No Filing Date (Notice), which advised Applicants that the basic filing fee, claims fee, and the oath or declaration were missing. The first paragraph of the September 14, 1993 Notice states:

Required items 1-9 below SHOULD be filed, with any items required on the "Notice of Incomplete Application" enclosed with this form. The filing date of this application will be the date of receipt of the items required on the "Notice of

Incomplete Application.” If items 1 and 3-6 below are submitted after the filing date, THE PAYMENT OF A SURCHARGE of \$130 large entities or \$65 for small entities who have filed a verified statement \*\*\*\* will also be required [emphasis added].

Item 1 of the Notice is directed to the basic filing fee and item 3 is directed to the missing oath or declaration. The Notice also stated that these items **SHOULD** be filed with the items required by the Notice of Incomplete Application – it did not state that they ‘**MUST**’ be filed with the items required by the Notice of Incomplete Application. The fact that the filing fee and declaration did not have to be submitted with the response to the Notice of Incomplete Application is supported by the statement thereafter, which reads: “[i]f items 1 and 3-6 below are submitted after the filing date,” then payment of a surcharge would also be required. Therefore, applicants had the option to delay paying the filing fees and submitting the oath or declaration after the application was accorded a filing date. Further, attention is directed to MPEP Section 608.01, Fifth Edition, Rev. 15, August 1993, which states:

If any applicant believes that the omitted pages of the application are not necessary for an understanding of the subject matter sought to be patented, applicant may petition to have the application accepted without the omitted pages. Any petition must be accompanied by the petition fee (37 CFR 1.17(h)) and an amendment canceling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and renumbering the pages present in consecutive order. Also, if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by applicant stating that the invention is adequately disclosed in, and a desire to rely on, the application as thus amended for purposes of an original disclosure and filing date. If the oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, when filed, must include a specific reference to the amendment cancelling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support. [Emphasis supplied].

As this application was filed without an oath or declaration and no oath or declaration was filed prior to the date of the petition under 37 C.F.R. §§ 1.53 and 1.182 and accompanying amendment, the USPTO’s own procedures did not require the submission of an oath or declaration as a condition



for a grantable petition for a filing date. Therefore, the USPTO erred in its decision of February 16, 1994 by requiring a supplemental oath or declaration when, in fact, no oath or declaration had ever been filed in this application.

MPEP Section 601.01, the pertinent MPEP edition in effect at the time of the filing of this application, includes a list of all the forms used by Application Branch to notify applicants of defects in their applications. Among these forms is a Notice to File Missing Parts of Application-No Filing Date. The first paragraph of that form states that the Office is bringing to petitioner's attention at this time that a surcharge would be required "if items 1 and 3-6 [which here would include items 1 and 3 for the filing fee and oath or declaration] are filed after the filing date." This form, after item 8, includes the following language:

Required items 1-7 above SHOULD be filed, **if possible**, with any items required on the "Notice of Incomplete Application" enclosed with this form. If concurrent filing of all required items is not possible, items 1-7 above must be filed no later than two months from the filing date of this application. The filing date will be the date of receipt of the items required on the "Notice of Incomplete Application." If items 1 and 3-6 above are submitted **after** the filing date, THE PAYMENT OF A SURCHARGE OF \$ \_\_\_\_ for large entities, or \$ \_\_\_\_ for small entities who have filed a verified statement claiming such status, is required. (37 CFR 1.16(e)).

**Applicant must file all the required items 1-7 indicated above within two months from any filing date granted** to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). [Emphasis supplied].

As noted by Mr. Nase in his Declaration, the version of the Notice to File Missing Parts of Application mailed by Application Division on September 14, 1993 was not the same version of the Notice reproduced in MPEP Fifth Edition, Rev. 15, August 1993, the version in effect at the time of filing of this application. The version mailed by Application Division did not set a two month period for submission of the missing items, while the version in effect at the time of filing this application did set a two month period from the filing date of the application for the submission of the missing items. Nevertheless, except for this difference, the language in both Notices makes it

clear that the filing fee and oath or declaration could be submitted after a filing date has been accorded the application.

MPEP Section 601.01 Fifth Edition, August 1993, states, in part:

37 CFR 1.53(b) provides that a filing date is assigned to an application as of the date a specification containing a description and claim and any required drawings and the names of all inventors are filed in the Patent and Trademark Office. Failure to meet any of the requirements in 37 CFR 1.53(b) will result in the application being denied a filing date. The filing date to be accorded such an application is the date on which all the requirements of 37 CFR 1.53(b) are met. **Although the filing fee and oath or declaration can be submitted later,** no amendments can be made to the specification or drawings which will introduce new matter. \* \* \*

**Effective February 27, 1983, in accordance with the provisions of 35 U.S.C. 111 and 37 CFR 1.53(b), a filing date is granted to an application for patent, which includes at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR 1.81(a), which is filed in the Patent and Trademark Office and which names the actual inventor or inventors pursuant to 37 CFR 1.41(a) [emphasis added].**

The statute at 35 U.S.C. § 111 in effect at the time of the filing of this application stated: “[t]he fee and oath may be submitted after the specification and any required drawings are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner.” Further, 37 C.F.R. § 1.53(d) in effect at the time of filing this application, stated: “[i]f an application which **has been accorded a filing date** pursuant to paragraph (b) of this section does not include the appropriate filing fee or an oath or declaration by applicant, the applicant will be so notified \* \* \* and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in §1.16(e) in order to prevent abandonment of the application.” As this application was not accorded a filing date, the basic filing fee or oath or declaration were not required as a condition for the granting of a filing date to this application. All that Applicants were required to do at the time of filing the petition for filing date on October 29, 1993 was to file a petition and fee stating that the omitted page was not necessary

for an understanding of the invention and, according to the procedures in effect at the time, as noted above in MPEP 608.01, file an amendment canceling from the specification all incomplete sentences and any claims which depend upon the omitted pages and renumbering the pages present in consecutive order. However, it is noted that, while the Notice of Incomplete Application itself did not make a requirement for an amendment to the specification, Petitioner not only timely filed the petition for filing date, making the statement that the omitted page was not necessary for an understanding of the invention, but also included the amendment to the specification. Despite Applicants' compliance with the Notice of Incomplete Application, the USPTO arbitrarily refused to grant a filing date to the timely filed petition of October 29, 1993 because the petition was not accompanied by a supplemental oath or declaration, which refusal was in direct contradiction to the procedure set out in both the Notice to File Missing Parts of Application mailed on September 14, 1993 and the statute, rule and MPEP guidelines. The decision dismissing the petition of October 29, 1993 was not based on the USPTO's own stated internal policy.

Therefore, not only was this application entitled to a filing date on filing, but was again entitled to the filing date of August 31, 1993 in view of the timely filing of the October 29, 1993 petition wherein Applicants had clearly satisfied the requirement in the Notice of Incomplete Application for a filing date.

The USPTO decision of February 16, 1994 was clearly in error in that (1) it did not then grant the requested filing date of August 31, 1993; and (2) conditioned any future grant on the submission of a supplemental oath or declaration. As Applicants had complied with the requirements for the granting of a filing date, Mr. Nase states in his Declaration that the decision of February 16, 1994 should have granted the petition of October 29, 1993 and the decision should have either (1) set an extendible period for submitting the filing and surcharge fees and the oath or declaration, or (2) returned the application file to Application Branch for mailing of a Notice to File Missing Parts of Application-Filing Date Granted setting an extendable period for submitting the filing fees and oath or declaration. Instead, the decision of February 16, 1994 set a non-extendable period of two months for submitting a supplemental oath or declaration. Had Applicants been

properly given an extendable period under the provisions of 37 C.F.R. § 1.136(a) in the decision of February 16, 1994, then Applicants could conceivably have had sufficient time to obtain the required declaration executed by all the inventors and/or filed a petition under 37 C.F.R. § 1.47(a) to accept the declaration by less than all the inventors. This statement is supported by the fact that an executed declaration by all the available inventors and a petition under 37 C.F.R. § 1.47(a) were filed on August 29, 1994 in the continuing '985 application. Therefore, it was because of this very fatally flawed decision that Applicants were forced to file the '985 application due to the difficulties encountered in obtaining a declaration executed by all the named inventors within the non-extendable two month time period set in the decision of February 16, 1994.

Mr. Nase further states in his Declaration that it is his opinion that the declaration by the applicants submitted in the '985 continuing application in support of the 37 C.F.R. § 1.182 petition in the '985 application should be considered sufficient to correct the deficiency in the 37 C.F.R. §§ 1.53 and 1.182 petition in this application that was noted in the February 16, 1994 dismissal of the petition of October 29, 1993. In this respect, the '985 application was filed on February 28, 1994, which also was missing the title page of the specification. In the '985 application, a petition was timely filed on September 11, 1995 requesting that the application be accorded a filing date of February 28, 1994. The petition to accord the '985 application the original filing date of February 28, 1994 was granted on September 15, 1995, which decision also granted the petition under 37 C.F.R. § 1.47(a) to accept the application without the signatures of all the inventors. Therefore, as the facts in the instant application and the continuing '985 application were the same, Mr. Nase's Declaration submits that the September 15, 1995 grant of the petitions in the '985 application, *sub silentio*, granted relief in the underlying '955 application.

#### 4. PTO's Later Action Contradicted Treatment of '955 Application

Attention is further drawn to the '985 continuing application, which application was filed on February 28, 1994, prior to the effective July 22, 1996 filing date change, and which also was missing a page of the specification. However, that application was granted a filing date, which was

in direct contradiction to the USPTO's handling of the petition filed in the '955 application. Therefore, it appears that the USPTO was inconsistent with its own flawed procedures in the treatment of applications filed without all pages of the application. In response to a petition filed on September 11, 1995 in the '985 continuing application requesting that the application be accorded a filing date of February 28, 1994, the USPTO, on September 15, 1995, prior to the effective July 22, 1996 filing date change, granted petitioner's request for the original filing date of February 28, 1994 (and also granted a petition under 37 C.F.R. § 1.47(a) to accept the application without the signatures of all the inventors). The USPTO maintained in the 2009 Decision that Petitioner cannot rely upon later promulgated statutes, rules, and procedures to support his assertions that a filing date of August 31, 1993 be granted to the instant application. Therefore, the position of the USPTO in not granting a filing date, on the same facts, is arbitrary and capricious.

For the above reasons, the USPTO's decisions not to grant this application a filing date were arbitrary, capricious and contrary to law then and now in effect. The USPTO recognized that its practice was not consistent with the statute and rules by its implementation of a policy that an application is entitled to a filing date where it contains a specification, at least one claim, and any required drawing, even though all the pages of the specification were not present on filing. The USPTO in its policy decision of July 22, 1996 disavowed the very practice that is still being arbitrarily applied to refuse the petition for filing date in this application. Accordingly, Petitioner is entitled to the requested filing date of August 31, 1993 and requests that this application be so accorded that date.

**B. ARGUMENTS AS TO WHY PETITION FOR FILING DATE SHOULD BE CONSIDERED TIMELY**

The 2009 Decision again refused to consider the petition for filing date on the basis that it was not timely submitted. In this regard, the decision stated that Petitioner was thrice put on notice, "not only in the letter mailed by Application Division on September 14, 1993 but also in the petition decision mailed February 16, 1994, that the above-identified application did not have a filing date

and was further made aware by such petition decision what was required in order to obtain a filing date.” The 2009 Decision further stated that the Notice of Abandonment provided even further notice of the lack of a filing date. Moreover, the Decision states that petitioner was given two months from the mailing date of the February 16, 1994 petition decision to file a request for reconsideration, but chose not to file such request and that to now state that petitioner was first notified of the lack of such filing date on October 5, 2007 is misplaced.

As to the Notice of Incomplete Application mailed September 14, 1993 by Application Division to Applicants’ counsel, Mr. Grossman, Petitioner submits that the Notice was in fact timely responded to on October 29, 1993, which response was well within the two month period set therein. However, despite the fact that all the conditions for a grantable petition for filing date had been satisfied, the USPTO arbitrarily and erroneously dismissed the petition for the reasons noted *supra*. Nevertheless, in an attempt to satisfy the conditions set out in the February 16, 1994 petition decision, a four month extension of time and a continuing application were filed on February 28, 1994. However, the continuing application was also filed with the first page of the specification missing but was nevertheless granted a filing date. The fact that the continuing application was considered by the USPTO to have been improperly accorded a filing date was not brought to the attorney’s attention until a telephone conversation with Ms. Magdalen Y.C. Greenlief, whereupon a petition for filing date was promptly filed. The petition for filing date was granted, along with the petition under 37 C.F.R. § 1.47(a). It would have been reasonable for Applicants to be under the impression that Ms. Greenlief had also reviewed this case at the time of deciding the petition for filing date in the continuing application (as she would have had to before granting a filing date to a continuing application) and that, by granting the petition for filing date, also blessed the filing date issue in the present application. It has been shown that the February 16, 1994 decision by the USPTO was in error and that such error was recognized by the granting of the requested relief for filing date by Ms. Greenlief in continuing Application No. 08/202,985. To now hold that the petition for filing date is untimely is unfair because Applicants were unaware that there was a problem until so apprized on October 5, 2007 by the defendants in a litigation suit involving this

case. This is especially true in view of the fact that Applicants received not one, but two, filing receipts which indicated co-pendency with both this application and the '985 continuing application. Further, the patent which issued from the '985 application included a priority claim to grandparent Application No. 07/426,917, as well as to the present application. Therefore, Petitioner had no reason to believe there was a problem in co-pendency between this application and the '985 continuing application. The issuance of the two filing receipts and printing of the claim for benefit of priority on the Letters Patent to both the grandparent and parent applications led Applicants into a false sense of security that there was no issue with the copendency requirements. It is further noted that 37 C.F.R. § 1.131 declarations were filed in the '985 continuing application by some of the inventors on March 17, 1998 stating that he is a "co-inventor of the above-identified application, which is a cont. of App. Ser. No. 08/113,955, filed 8/31/92, now abn'd, which is a continuation of app. Ser. No. 07/426,917, filed 10/26/89, Pat. No. 5,241,671." This further reinforces the belief that Applicants were unaware of any copendency problems.

The 2009 Decision further stated that 1059 *Off. Gaz. Pat. Office* 4 is inapplicable here where applicant was informed of both the lack of a filing date in and the abandoned status of this application and holding that the action here was nothing like the discontinued practice of filing a File Wrapper Continuing case under 37 C.F.R. § 1.62. However, Petitioner cited this Notice as analogous to the facts of this case since the USPTO not only issued two filing receipts, but also printed the claim for priority on the front page of the patent which issued from the '985 continuing application. As noted above, Applicants could have reasonably believed that the filing date issue in this case was resolved by the decision by Ms. Greenlief granting the petition for filing date in the '985 continuing application, and the USPTO reinforced and contributed to this belief by the issuance of the two filing receipts and by printing the priority information of the grandparent and parent applications on the front page of the Letters Patent.

Further, in support of Applicants' position that the USPTO contributed to Applicants' lack of awareness of the true status of this application relative to the copendency requirement of the '985 application, Petitioner points out that, in five other applications, the USPTO gave full weight and

credit to a claim for benefit of priority back to the present application, as well as to the very first application in this chain, namely, Application No. 07/426,917, filed October 26, 1989. The five applications affected by the priority claim to this application are listed below:

Application No. 10/103,814, filed March 25, 2002, now Pat. No. 6,978,277, which issued on December 20, 2005.

Application No. 11/150,494, filed June 13, 2005, now Patent No. 7,082,437, which issued on July 25, 2006.

Application No. 11/150,812, filed June 13, 2005, now Patent No. 7,051,081, which issued on May 23, 2006.

Application No. 11/150,813, filed June 13, 2005, now Patent No. 7,085,778, which issued on August 1, 2006.

Application No. 11/490,263, filed July 21, 2006, now pending.

In the first four applications cited above, the PTO issued filing receipts claiming benefit of priority to this application, as well as to the very first application in the chain (the '917 application), and all issued with the priority claim to this application and to the '917 application printed on the patent grant. The last application, No. 11/490,263, is still pending, and the claim for benefit of priority to the present application, as well as to the very first application in the chain (the '917 application), appears on the filing receipts issued in this application. Additionally, a review of the examination history of the above cases indicates that even the Examiner's computer searches of the prior art patents, pre-grant publications, and the foreign patent literature are limited to references having an effective date earlier than that of the October 26, 1989 date of the very first application filed in this chain of applications. Additionally, the pre-grant publications of these applications also include a claim for benefit of priority back to the first application filed, as well as to the present application. A chart, *infra*, is included in this petition to show the USPTO's actions in the above cases for a period spanning 14 years, a record that fails to bring to light any failure by Applicants to have perfected the filing date of the present application which was being relied on for continuity purposes. These are all positive, documented, official acts by the USPTO, that are also publicly



available, to show that the USPTO has both in its procedural roles, and in its examining roles acknowledged and accorded benefit of the claim for priority under 35 U.S.C. § 120 to this application as if it had properly been accorded a filing date and the entire chain of continuity been met. The 2009 Decision does just that—it denies the role that the USPTO has had for the last 14 years in causing or contributing to the Petitioner's (and the members of the public's) failure to appreciate that, in fact, the USPTO does not consider this application to have been accorded a filing date.

The courts have made it clear--that when, as here, the USPTO causes or contributes to a condition ultimately adverse to an applicant--the USPTO is obligated to exercise its remedial powers and remedy the situation. *See Helfgott & Karas, P.C. v. Dickinson*, 209 F.3d 1328, 1336 (Fed. Cir. 2000). ("Even if total elimination of mistakes is an illusory goal, their reasonable mitigation should not be.") Here, as the USPTO acknowledged in the July 22, 1996 Change in Procedure Relating to an Application Filing Date that no statute or regulation would have been violated on August 31, 1993 -- much less today -- in granting this application a filing date of August 31, 1993, there is no bar to that mitigation.

Chart of Bold-faced Positive, Documented, Official Acts by USPTO according § 120 benefit to US  
App. No. 07/426,917 (now US 5,241,671) through U.S. Application No. 08/113,955

App. No. PGPUB# Pat. No.	1989	1990	1991	1992	1993	1994	1995	1996	1997-01*	2002	2003	2004	2005	2006	2007	2008	2009
07426917 5,241,671																	
08113955																	
08202985 6,546,399						<b>FR</b>	<b>FDPG</b>	<b>OA</b>		<b>OA</b>	<b>PD</b>						
10103814 124004A1 6,978,277										<b>FR</b> <b>PGP</b>		<b>SS</b> <b>OA</b>	<b>SS</b> <b>PD</b>				
11150494 262066A1 7,082,437												<b>FR</b> <b>PGP</b>	<b>SS</b> <b>OA</b>	<b>SS</b> <b>OA</b> <b>PD</b>			
11150812 251515A1 7,051,018													<b>FR</b> <b>PGP</b> <b>SS</b> <b>OA</b>	<b>SS</b> <b>OA</b> <b>PD</b>			
11150813 262073A1 7,085,778													<b>FR</b> <b>PGP</b> <b>SS</b> <b>OA</b>	<b>SS</b> <b>OA</b> <b>PD</b>			
11490263 179977A1														<b>FR</b>	<b>PGP</b> <b>CFR</b>		<b>OA</b>

- USPTO suspended prosecution in 08/202,985 from 8/97 through 3/02

Shaded Area= Application/ PreGrantPub/Patent lifeline

Legend

FR= Filing Receipt listing § 120 benefit claim

PGP=PGPub listing § 120 claim

CFR= Corrected Filing Receipt listing § 120 benefit claim PD=Patent Issued listing § 120 claim

FDPG= Filing Date Petition Granted

SS= Examiner's Search Strategy according § 120 benefit

OA=Examiner's Office Action applying prior art based on § 120 benefit

As stated above, the above-noted applications all included either on the filing receipts, the patent grants, or the pre-grant publications, a claim for benefit of priority back to this application, as well as to the very first application filed in the chain. The USPTO's statement that, for Petitioner "to

now state that petitioner was first notified of the lack of such filing date on October 5, 2007 is misplaced,” is grossly unfair and unfounded in view of the numerous contributory acts, as shown further in the chart above, by the USPTO which led Applicants to reasonably believe that this application was properly and successfully given a filing date in order to perfect the benefit of the claim for priority in the ‘985 application (as well as the other continuing applications). In view of the continued prosecution from October 26, 1989 to the filing of the July 21, 2006 application, and the fact that the USPTO gave full weight and credit to the priority claims in all the applications back to the present application, as evidenced by the USPTO’s own record, lulled Applicants into a false sense of security believing that there was no issue with copendency between this application and the ‘985 application. Because of the contributory acts by the USPTO, *Applicants were unaware of any issues as to lack of copendency between this application and the ‘985 application until October 5, 2007*. Once Applicants became aware of the asserted issue, a petition for filing date was promptly and timely filed.

The USPTO’s contention that Petitioner has not shown or alleged that the general public will not be harmed by the granting of the desired filing date in this “long-abandoned application,” Petitioner contends that the public is unharmed because it was unaware of any asserted copendency issue between this application and the ‘985 application, especially in view of the USPTO’s issuance of patent grants in four other continuing applications, giving full weight and benefit to a claim for priority to this application. As the public was unaware of any problem for a period spanning at least 14 years, to now formally grant a filing date of August 31, 1993 to this application would cause no harm to those relying upon the filing date of this application. As noted in the Declaration by Mr. Nase, due to the effect that the loss of a filing date can have on an application, the USPTO generally treats untimely filing date petitions on their merits since the application, as incomplete, will have undergone no further processing or examination (as in the present case). The USPTO has recognized the unfairness of the harsh consequences that applicants may suffer when a filing date is not granted under these types of circumstances.

Accordingly, for the above reasons, Petitioner contends that, due to the contributory actions by the USPTO in the issuance of filing receipts, patent grants, and pre-grant publications with a claim for benefit of priority between this application and the '985 application, as further evidenced by the Examiner's computer searches, this petition for granting of a filing date was promptly filed once Applicants were notified on October 5, 2007 of an asserted lack of copendency in a litigation suit involving this application. Therefore, Petitioner respectfully requests that the USPTO grant the timely filed petition for a filing date of August 31, 1993 to this application.

**C. DISCUSSION OF FILING FEE ISSUE**

The 2009 Decision stated that, despite petitioner's statement that the fees should be reallocated in view of a blanket fee authorization given in the February 28, 1994 petition for extension of time, no blanket fee authorization was given; that the only authorization was one to charge extension of time fees; that the statement in the petition for extension of time that "the commissioner is authorized to charge any fee or additional amounts due in connection with this communication," was not a blanket authorization to charge the filing fee, additional claim fees, and surcharge fee; that to do so would be wholly inappropriate since the attorney, Mr. Grossman, did not intend such in view of his failure to respond to the petition decision of February 16, 1994; and that 37 C.F.R. § 1.22(b) required an itemization in such a manner that it was clear for which purpose the fees are paid. The 2009 Decision construed the authorization solely as one to charge an extension of time fee and that no reallocation of fees will be undertaken. Further, the USPTO will not accept any fees at this time since no filing date has been granted and proceedings have been terminated.

The petition for extension of time filed February 28, 1994, included the following statement:

A check in the amount of \$1,320.00 is attached. If no check is attached and a fee is due or if the check enclosed is insufficient, the Commissioner is authorized to charge any fee or additional amounts due in connection with this communication to Deposit Account No. 04-1073.

Mr. Nase states in his Declaration that it is his opinion that the fee language set forth in the February 28, 1994 extension of time request filed in this application was sufficient authorization to charge the processing and retention fee as then provided by 37 C.F.R. § 1.21(l). As the extension of time noted that a continuation application under 37 C.F.R. § 1.53 was being filed on that same day, it is clear that the fee required in connection with this communication would have been payment of the retention fee in order to claim benefit of priority under 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a) then in effect. Mr. Nase further notes in his Declaration that, while 37 C.F.R. § 1.22(b) provided that all patent fees paid to the USPTO should be itemized in each individual application in such a manner that it is clear for which purpose the fees are paid, 37 C.F.R. § 1.22(b) does not require such itemization. The practice of the USPTO did not require an itemization in order to charge a fee to a deposit account. As an example, a claim amendment which requires additional claim fees would have needed claim fees charged to a deposit account if there was a general authorization to charge any fee due. Therefore, Mr. Nase's Declaration states that it is his opinion that the fee language set forth in the February 28, 1994 extension of time filed in this application was sufficient authorization to charge the processing and retention fee as then provided by 37 C.F.R. § 1.21(l).

Mr. Nase states in his Declaration that, for the reasons given, this application is entitled to the August 31, 1993 filing date under the statutes, regulations and procedures in effect at that time. It is Mr. Nase's further opinion that, the Notice to File Missing Parts of Application mailed on September 14, 1993 did not set a time period for paying the appropriate filing and surcharge fees and for submitting the oath or declaration. As noted above, the decision mailed on February 16, 1994 should have been granted and, pursuant to the missing parts practice, the decision should either (1) have set an extendible period for submitting the filing and surcharge fees and an executed oath or declaration (or, in this case, a petition under 37 C.F.R. § 1.47(a)), or (2) returned the application file to Application Division for the mailing of a Notice to File Missing Parts of Application – Filing Date Granted, setting an extendible period for supplying the missing parts. It is further Mr. Nase's opinion that, since this application is still pending with a filing date of August 31, 1993, it is still possible for Applicants to timely pay the filing fees. In the event that the PTO

Deciding Official finds that the filing fees must be paid at this time and that any unnecessary payments previously made be refunded, the PTO is hereby authorized to charge the filing fees to Petitioner's Deposit account given below.

Should the USPTO still consider that this application is not entitled to the August 31, 1993 filing date, it is pointed out that, at the time of filing the petition for extension of time, this application had not been formally accorded a filing date as a result of the USPTO's unfortunate actions or inactions herein. Therefore, as this case, according to the USPTO, had not been accorded a filing date, it follows that no filing fees were due and no extension of time fees were owed, since extension of time fees under 37 C.F.R. 1.136(a) *are only applicable to pending applications*. As such, the \$1,320 extension of time fee submitted was a fee paid where no fee was due; yet, this fee was accepted by the USPTO and has not been refunded. This retained fee is more than enough to cover the basic filing fee, or certainly the \$130 processing and retention fee, which was the minimum fee then owed, that permitted an applicant under then 37 C.F.R. § 1.78, even in an incomplete application, to present a claim for benefit of priority under the rule to a prior application. Therefore, upon the granting of a filing date to this application, Petitioner requests that the USPTO apply the superfluous extension of time fee long ago paid to the USPTO, and, despite not being owed to the USPTO, still in the possession of the USPTO, toward the filing fee and/or retention fee. In this regard, while the processing and retention fee of former 37 C.F.R. § 1.21 no longer exists, the USPTO has maintained that it will apply the rules in effect at the time this application was filed to this application. Petitioner points out that, at the time this application was filed, 37 C.F.R. § 1.78(a) permitted an applicant to claim benefit of a prior application even if it was itself incomplete, or the prior application was itself incomplete, (*i.e.*, did not have a declaration and/or had not paid the entire filing fee), so long as \$130 of the processing and retention fee set forth in 37 C.F.R. § 1.21(l), was paid. *See* 37 C.F.R. § 1.78(a) (1993). Here, Petitioner has paid at least 10 times the amount needed for any priority claim to the USPTO. Therefore, the USPTO had in its possession the fee necessary to comply with the filing fee requirements and 37 C.F.R. § 1.78(a). Furthermore, the PTO did not and does not have a practice of requiring itemization as in "must" itemize, or else

the fee will not be accepted. Rather, it was always as in "should" be itemized in order to ensure proper fee application by the PTO.

**D. MISCELLANEOUS COMMENTS**

The 2009 Decision maintained that Korsinsky (Korsinsky v. Godici, 2005 U.S. LEXIS 20850 (2005)) is applicable to the present situation (see 2009 Decision, top of page 9). The 2009 Decision states that, in both cases, (1) "petitioner deliberately chose a course of action" and (2) later, "due to infringement," "realized... the error of that previous decision," and "chose an opposite course of action." In fact, the two cases are plainly and fundamentally different in both respects.

With respect to the first point, the reason Korsinsky did not pay maintenance fees when they were due was because his wife thought the money was not worth it. Basically, he just walked away from his patent because he did not want to spend the money. In contrast, the Applicants in the present case at all times took steps seeking to maintain the pendency of at least one patent application, to preserve copendency to the original October 26, 1989 filing date. At every turn, the Applicants took at least some action that can only be understood as an effort to maintain copendency.

The "error" in Korsinsky's case was that he made a bad business decision. He (or at least his wife) thought that the patent was not worth the maintenance fee, and so he let it expire. Then he wanted to change his mind when it was learned that the patent might have value. The present case is very different. Applicant never made a business decision to walk away from copendency through the '955 application. The "error," if any, was a formalistic one brought to its attention by a third party in ongoing litigation -- a third party with substantial resources and incentive to uncover any possible procedural irregularity.

On the issues of timeliness, and the applicability of the Rules, the Helfgott case is much more analogous to the present case -- more analogous than Korsinsky. In the Helfgott case, the applicant made a mistake. He filed a PCT Demand incorrectly. The PTO compounded the error in a way that made it more difficult for Helfgott to realize in a timely fashion that there was any problem. Helfgott's petition for relief was dismissed as untimely. The Federal Circuit determined that the PTO's refusal to grant relief under Rule 183 was an abuse of discretion.

The 2009 Decision states in the middle paragraph of page 9 that the requirements of the Office letter of September 14, 1993, the Decision of February 16, 1994, and MPEP 608.01 have yet to be met, and in any event, were not timely met. Petitioner respectfully requests clarification on this point. All fees have been authorized to be charged to Petitioner's deposit account, including any filing fees, additional claim fees and surcharge required. The Supplemental Declaration indicating the inventors agreement that the invention is adequately disclosed without original page 1 has been filed. Thus, all requirements have in fact been met. The fact that the requirements were timely met, has been discussed at great length above.

The 2009 Decision indicates in the penultimate paragraph of page 11 that Petitioner has not shown nor alleged that the general public will not be harmed by the granting of the desired filing date. Continuing applications filed from the present application made clear that benefits to this application as well as its parent application were being claimed. Upon review of the present application and the '985 application, the only possible conclusion one can draw is that the present application was abandoned in favor of the '985 application. It is therefore clear that the invention covered by the '955 application was never abandoned. It is only the file of the '955 application that was allowed to be abandoned in favor of one or more continuing applications. The equity is clearly on Applicants' side.

The 2009 Decision indicates at the bottom of page 11 that the declarations submitted are not in compliance with MPEP 608.01 (Fifth Edition Rev. 15) and in any event are untimely.



Clarification is respectfully requested as to the nature of lack of compliance. Again, the timeliness issue has been addressed above.

**Request to amend this application for priority to Application No. 07/426,917**

As it is Petitioner's position that this application is pending and entitled to the filing date of August 31, 1993, Petitioner submits that the requirements for claiming benefit of priority under 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a) have long since been satisfied. Therefore, Petitioner again requests that this application be amended to formally claim benefit of priority to Application No. 07/426,917. The amendment was first submitted with the petition of November 1, 2007.

**Relief Requested**

In sum, Petitioner requests the USPTO to:

- (1) formally accord a filing date of August 31, 1993 to this application for the reasons given above;
- (2) apply the processing and retention fee in effect at the time this application was filed by reallocating the fee from the \$1,320 extension of time fee still in the possession of the USPTO, and refund the balance of the extension of time fee;
- (3) or, if the USPTO deems that the filing fee should be paid, then Petitioner requests that the filing fee be reallocated from the \$1,320 extension of time fee and the balance be refunded;
- (4) amend this application to claim priority to Application No. 07/426,917 and issue a filing receipt therefor; and
- (5) if necessary, take appropriate action on the Petition under 37 C.F.R. § 1.47(a) (that Petition was simply filed at the urging of the PTO deciding official in the initial

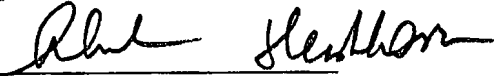
dismissal of the Petition, but is not believed to be necessary as Applicant does not wish to further prosecute this application other than having a filing date granted and then having it re-abandoned in favor of the continuation applications already on file).

- (6) The USPTO is authorized to charge any fees required for a grantable petition, including, but not limited to, any retention fees, filing fees, or petition fees to Deposit Account No. 50-2929, making reference to Docket Number J8300.1.

The Deciding Official is invited to contact the undersigned with any unresolved issues that would lead to a favorable decision on this Request/Petition.

Dated: May 4, 2009

Respectfully submitted,

By 

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*part of #29*

**DECLARATION IN SUPPORT OF REQUEST FOR  
RECONSIDERATION/PETITION FOR SUPERVISORY REVIEW OF  
DECISION DENYING PETITION FOR A FILING DATE IN  
APPLICATION NO. 08/113,955**

I provide this Declaration in support of a Request for Reconsideration/Petition for Supervisory Review of Decision Denying Petition for a Filing Date in Application No. 08/113,955.

I, Jeffrey V. Nase, hereby declare that:

**I. INTRODUCTION**

1. I have been asked by Encyclopaedia Britannica, Inc., ("Britannica") to provide my opinion as to whether Application No. 08/113,955 ("the '955 application") is entitled to a filing date of August 31, 1993 and if the '955 application can be relied upon for priority under 35 U.S.C. § 120.

**II. QUALIFICATIONS**

2. I received a B.S. in Mechanical Engineering from Drexel University in 1973. I received a Juris Doctor degree from George Mason University in 1986. I was admitted to the Bar of the Commonwealth of Virginia in 1986.
3. I became a Patent Examiner at the United States Patent and Trademark Office ("USPTO") in 1973 in the conveying and transportation related technological art area. I received the authority to grant or deny patents over my own signature in 1979.
4. In 1987, I was appointed to supervise the Office of Petitions. In 1993 I held the title of Director of the Office of Petitions and in 1994, this position became the Patent

Legal Administrator in the Office of the Deputy Assistant Commissioner for Patent Policy & Projects. The duties of these positions included: (1) Rulemaking, Official Gazette Notices and Patentability Guidelines; (2) Deciding petitions that came under the authority of the Office of the Deputy Assistant Commissioner for Patent Policy & Projects, including filing date petitions; and (3) Special projects such as conducting briefings on legal topics for visiting officials.

5. In 1996, I was appointed as an Administrative Patent Judge and member of the Board of Patent Appeals and Interferences ("the Board") in the USPTO. The Board's decisions constitute final agency determinations with respect to substantive questions of patent law. They are reviewable directly by the Federal Circuit or by the United States District Court for the District of Columbia, whose decisions, in turn, are reviewable by the Federal Circuit.
6. In February 2006, I retired from the Board and the USPTO. In June 2006, I became a member of the intellectual property law firm of Oblon, Spivak, McClelland, Maier & Neustadt, P.C. ("the Oblon firm") in Alexandria, Virginia, specializing in all phases of patent application preparation and prosecution. I left the Oblon firm in early December 2006. From mid December 2006 through the present I have been a consultant to HersHKovitz & Associates, LLC by providing assistance with some of their more complex patent matters such as reexamination, appeals to the Board of Patent Appeals and Interferences and petition practice at the USPTO.
7. During my career, I have been involved in numerous aspects of patent practice, including the determination of the official filing date of an application filed in the USPTO.

### III. MATERIALS REVIEWED

8. In forming my opinion and preparing this Declaration, I have reviewed the file histories of the '955 application, Application No. 08/202,985 ("the '985 application") and U.S. Patent No. 5,241,671 and the pertinent sections of Title 35 U.S.C., Title 37 C.F.R. and the Manual of Patent Examining Procedure ("MPEP").
9. As the '955 application was deposited with the USPTO on August 31, 1993, the statutes, rules, and procedures in effect at that time will be relied upon in forming my opinion as to whether the '955 application is entitled to a filing date of August 31, 1993 and if the '955 application can be relied upon for priority under 35 U.S.C. § 120.
10. At the time the '955 application was deposited with the USPTO on August 31, 1993:

35 U.S.C. § 111 stated:

Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed section 115 of this title. The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawings are submitted, within such period and under such conditions, including payment of a surcharge, as may be prescribed by the Commissioner. Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee and oath was unavoidable. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

35 U.S.C § 120 stated:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an

inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

37 CFR § 1.22(b) stated:

All patent and trademark fees paid to the Patent and Trademark Office should be itemized in each individual application, patent or other proceeding in such a manner that it is clear for which purpose the fees are paid.

37 CFR § 1.53(b) stated:

The filing date of an application for patent filed under this section is the date on which: (1) a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and (2) any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No new matter may be introduced into an application after its filing date (§ 1.118). If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(i)(1) is filed which sets forth the reasons the delay in supplying the names should be excused. A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) may be filed pursuant to the section, § 1.60 or 1.62. A continuation-in-part may be filed pursuant to this section or § 1.62.

37 CFR 1.53(d) stated:

If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the appropriate filing fee or an oath or declaration by applicant, the applicant will be so notified, if a correspondence address has been provide and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(1) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of.

37 CFR 1.72(a) stated:

The title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification, if it does not otherwise appear at the beginning of the application.

37 CFR 1.77 stated:

The elements of the application should appear in the following order.

- (a) Title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention may be used.
- (b) (Reserved).
- (c)(1) Cross-reference to related applications, if any.
  - (2) Reference to a "microfiche appendix" if any. (See § 1.96(a)). The total number of microfiche and total number of frames should be specified.
- (d) Brief summary of the invention.
- (e) Brief description of the several views of the drawing, if there are drawings.
- (f) Detailed description.
- (g) Claim or claims.
- (h) Abstract of the disclosure.
- (i) Signed oath or declaration.
- (j) Drawings.

37 CFR 1.78(a) stated:

An application may claim an invention disclosed in a prior filed copending national application or international application designating the United States of America. In order for an application to claim the benefit of a prior copending national application, the prior application must name as an inventor at least one inventor named in the later filed application and disclose the named inventor's invention claimed in at least one claim of the later filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, the prior application must be (1) complete as set forth in § 1.51, or (2) entitled to a filing date as set forth in § 1.53(b) and include the basic filing fee set forth in § 1.16; or (3) entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(1) within the time period set forth in § 1.53(d). Any application claiming the benefit of a prior filed copending national or international application must contain or be amended to contain in the first sentence of the specification following the title a reference to such prior application, identifying it by serial number and filing date or international application number and international filing date and indicating the relationship of the application. Cross-references to other related applications may be made when appropriate. (See § 1.14(b).)

MPEP 601.01 stated:

The following forms used by Application Branch to notify applicants of defects are reproduced on the following pages. "Notice to File Missing Parts of Application - Filing Date Granted" form PTO-1533; "Notice to File Missing Parts of Application - No Filing Date"; form PTO-1532, "Notice of Informal Application" form PTO-152; "Notice of Incomplete Application", form PTO-1123, and "Notice of Incomplete Application filed Pursuant to 37 CFR 1.60" form PTO-1534.

The "Notice to File Missing Parts of Application - No Filing Date" (form PTO-1532) is reproduced at page 600-7 of the MPEP. The first paragraph of this form stated:

In order to avoid payment by applicant of the surcharge required if items 1 and 3-6 are filed after the filing date the following items are also brought to applicant's attention at this time.

Following item 8, this form included the following language:

Required items 1-7 above SHOULD be filed, if possible, with any items required on the "Notice of Incomplete Application" enclosed with this form. If concurrent filing of all required items is not possible, items 1-7 above must be filed no later than two months from the filing date of this application. The filing date will be the date of receipt of the items required on the "Notice of Incomplete Application." If items 1 and 3-6 above are submitted after the filing date, THE PAYMENT OF A SURCHARGE OF \$\_\_\_\_ for large entities, or \$\_\_\_\_ for small entities who have filed a verified statement claiming such status, is required. (37 CFR 1.16(e)).

Applicant must file all the required items 1-7 indicated above within two months from any filing date granted to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

MPEP 608.01 stated:

Applications filed without all pages of the specification are not given a filing date since they are "prima facie" incomplete. The filing date is the date on which the omitted pages are filed. If the oath or declaration for the application was filed prior to the submission of all pages of specification, the submission of any omitted pages must be accompanied by a supplemental oath or declaration referring to the specification originally deposited, as amended to include the pages originally omitted. If the oath or declaration for the application was not filed prior to the submission of the omitted pages, the oath or declaration when filed, must include a specific reference to pages originally omitted. If any applicant believes that the omitted pages of the application are not necessary for an understanding of



the subject matter sought to be patented, applicant may petition to have the application accepted without the omitted pages. Any petition must be accompanied by the petition fee (37 CFR 1.17(h)) and an amendment canceling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support and renumbering the pages present in consecutive order. Also, if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by the applicant stating that the invention is adequately disclosed in, and desire to rely on, the application as thus amended for purposes of an original disclosure and filing date. If the oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, when filed, must include a specific reference to the amendment cancelling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support.

#### **IV. BASIS OF OPINION**

11. My opinion is based on my personal knowledge and expertise, and my review and investigation of the items and materials described above.

#### **V. OPINION FORMED**

12. Application No. 08/113,955 is entitled to a filing date of August 31, 1993 and the '955 application can be relied upon for priority under 35 U.S.C. § 120 and 37 CFR § 1.78(a) for the reasons which follow.

##### **Application Histories**

13. On October 26, 1989, Application No. 07/426,917 ("the '917 application") was filed in the USPTO under 37 C.F.R. § 1.53. This application issued as U.S. Patent No. 5,241,671 on August 31, 1993.
14. On August 31, 1993, the '955 application was filed in the USPTO under 37 C.F.R. § 1.53. This application contained a two page cover letter stating that 68 pages of specification (including claims, abstract, etc.) and 20 pages of drawings were being

filed. The USPTO received the two page cover letter, 20 pages of drawings and 68 pages of specification. The 68 pages of specification consisted of an unnumbered title page followed by 67 pages numbered 2-68. The unnumbered title page included the following items in addition to the title: a listing of the 14 inventors by name, a docket number and the name and address of the law firm who prepared the application. Page numbered 2 started in mid-sentence. No filing fees were paid and no oath or declaration accompanied the application.

15. On September 14, 1993, the USPTO issued (1) a Notice of Incomplete Application, form PTO-1123; and (2) a Notice to File Missing Parts – No Filing Date, form PTO-1532. The Notice of Incomplete Application provided that no filing date was granted to the '955 application since page 1 was missing. The Notice to File Missing Parts – No Filing Date required that the filing fees of \$2,156 be paid and the oath or declaration be filed. However, this Notice to File Missing Parts – No Filing Date was not the version of the form PTO-1532 reproduced in the MPEP at page 600-7. Instead of setting a period to response of two months from any filing date granted to avoid abandonment, this Notice to File Missing Parts – No Filing Date did not set a period for response.
16. On October 29, 1993, the applicants filed a petition under 37 C.F.R. §§ 1.53 and 1.182 requesting the '955 application proceed without page 1 and that it be accorded a filing date of August 31, 1993. The petition included a statement that missing page 1 was not necessary for an understanding of the subject matter sought to be patented and was accompanied by the \$130 petition fee (37 CFR § 1.17(h)). The petition noted that no claims depended upon missing page 1 for disclosure and

support. The petition was accompanied by a preliminary amendment amending the incomplete sentence starting on page numbered 2 to be a complete sentence and requesting that the pages of the specification be renumbered.

17. On February 20, 1994, the USPTO dismissed the petition under 37 C.F.R. §§ 1.53 and 1.182 because an oath or declaration from the inventors stating their intention to rely on the application without page 1 was not included with the petition.
18. On February 28, 1994, the '985 application was filed in the USPTO under 37 C.F.R. § 1.53. This application contained a two page cover letter stating that 68 pages of specification (including claims, abstract, etc.) and 20 pages of drawings were being filed. The USPTO received the two page cover letter, 20 pages of drawings and 68 pages of specification. The 68 pages of specification consisted of an unnumbered title page followed by 67 pages numbered 2-68. The unnumbered title page included the following items in addition to the title: a listing of the 14 inventors by name, a docket number and the name and address of the law firm that prepared the application. Page numbered 2 started in mid-sentence. No filing fees were paid and no oath or declaration accompanied the application. The transmittal sheet accompanying the '985 application indicated that it was a 37 C.F.R. § 1.53 continuation of the '955 application. In addition, on February 28, 1994, the applicants filed a four month extension of time with its fee of \$1,320 in the '955 application. The extension of time included the following fee authorizing language "the Commissioner is authorized to charge any fee or additional amounts due in connection with this communication to Deposit Account No. 04-1073." The extension of time further included in the heading thereof the fact that this extension

was being requested to provide continuity to the 37 C.F.R. § 1.53 (Rule 53) continuation application being filed that day.

19. On March 18, 1994, the USPTO issued a Notice to File Missing Parts – Filing Date Granted in the '985 application. The Notice to File Missing Parts required that the filing fees of \$2,156 be paid, the oath or declaration be filed and a \$130 surcharge be paid.
20. On August 29, 1994, the applicants filed a timely response in the '985 application. The response included the filing fees, the surcharge, a declaration and a petition under 37 C.F.R. § 1.47 since all the inventors were not able to sign the declaration.
21. On January 19, 1995, the USPTO issued a Notice of Abandonment in the '985 application stating that no response was received to the March 18, 1994 Notice to File Missing Parts.
22. On March 23, 1995, the USPTO issued a Notice of Abandonment in the '955 application stating that applicant failed to submit the omissions identified in the Notice mailed on February 20, 1994 within the required two months.
23. On September 11, 1995, the applicants filed a petition under 37 C.F.R. § 1.182 requesting the '985 application proceed without page 1 and that it be accorded a filing date of February 28, 1994.
24. On September 15, 1995, the USPTO issued a decision granting the petitions under 37 C.F.R. §§ 1.47 and 1.182 in the '985 application. In this decision, the USPTO (1) withdrew the January 19, 1995 Notice of Abandonment since a timely response to the March 18, 1994 Notice to File Missing Parts had been filed; and (2) allowed

the '985 application to proceed without page 1 and accorded the '985 application a filing date of February 28, 1994.

25. On April 8, 2003, the '985 application issued as U.S. Patent No. 6,546,399. This patent claimed benefit under 35 U.S.C. § 120 to the '955 application and the '917 application.
26. On November 2, 2007, the applicants filed petitions under 37 C.F.R. §§ 1.53(b) and 1.182 for grant of a filing date of August 31, 1993 in the '955 application and to amend the '955 application to claim priority under 35 U.S.C. § 120 to the '917 application.
27. On August 6, 2008, the USPTO dismissed the petitions in the '955 application that were filed on November 2, 2007.
28. On October 6, 2008, the applicants supplemented the petitions in the '955 application that were filed on November 2, 2007 and requested that the petitions be reconsidered.
29. On March 4, 2009, the USPTO denied the petition in the '955 application that was filed on October 6, 2008.

#### **USPTO Filing Date Practice**

30. The USPTO changed its procedures relating to the treatment of prima facie incomplete applications effective July 22, 1996. This change in procedure is set forth in a Notice entitled "Proposed Changes in Procedures Relating to an Application Filing Date" ("Proposed Filing Date Notice"), published in the Federal Register at 60 FR 56982-84 (November 13, 1995) and a Notice entitled "Changes

in Procedure Relating to an Application Filing Date” (“Implemented Filing Date Notice”), published in the Federal Register at 61 FR 30041–46 (June 13, 1996).

Prior to July 22, 1996, the USPTO treated applications filed without all the pages of the specification as prima facie incomplete and did not accord such applications a filing date (“the old missing page procedure”). From July 22, 1996 forward, the USPTO treated applications filed without all the pages of the specification as complete and accorded such applications a filing date (“the new missing page procedure”).

31. I was named as a contact person in both the Proposed Filing Date Notice and the Implemented Filing Date Notice along with my employee Robert W. Bahr. After becoming the Patent Legal Administrator in 1994, I undertook a review of all filing date procedures including the procedure for handling pages omitted from an application filed under 37 CFR § 1.53. From that review, I concluded that there was no requirement in the statutes or regulations that an application filed under 37 CFR § 1.53 include sequentially numbered pages, or all of the pages to obtain a filing date. For example, an application filed under 37 CFR § 1.53 that contained specification pages numbered 1-3 and 5-75, claims numbered 1-10 and ten drawing figures was entitled to a filing date even though specification page 4 was prima facie missing. My conclusion resulted in the publication of both the Proposed Filing Date Notice and the Implemented Filing Date Notice.
32. The old missing page procedure (set forth in Section 608.01 of the MPEP in effect during 1993-1995) was that any application filed under 37 CFR § 1.53 without all the pages of the specification (e.g., with page numbering revealing that page(s) are

missing) was treated as prima facie incomplete and was not accorded a filing date.

In such event, the USPTO mailed a Notice of Incomplete Application indicating that a filing date had not been assigned to the application, and would indicate that:

(1) the filing date would be the date of receipt of the missing items, and (2) any assertion that the missing item was submitted, or not necessary for a filing date, had to be by way of a petition. To obtain the date of deposit of the application as the filing date, the applicant had to: (1) establish receipt in the USPTO of the allegedly missing item (generally by way of postcard receipt in accordance with MPEP § 503), or (2) petition to have the application accepted as deposited. A petition to have the application accepted as deposited required: (a) an amendment deleting all references to the missing item and correcting the sequential numbering of the pages in the application, (b) a request to cancel the missing item, if such missing item has been submitted after the date of deposit, and (c) a supplemental oath or declaration by the applicant stating that the invention was adequately disclosed in, expressing a wish to rely on the application as thus amended without the missing item and the references thereto in the specification, for purposes of an original disclosure and filing date. The supplemental oath or declaration by the applicant was in effect a statement in writing evidencing that the applicant had been informed of the content of his or her application as filed on the original date of deposit and that the actual content has been reviewed and understood.

33. The Proposed Filing Date Notice (at 60 FR 56983) indicated that (1) a significant number of applicants were willing to accept the application without the missing page, (2) the old missing page procedure resulted in numerous filing date petitions

which were time consuming and burdensome, (3) in most instances there was no controversy as to the content of the prima facie incomplete application (i.e., a grantable petition required only the above-mentioned corrective amendment(s) and supplemental oath or declaration), and (4) there was no requirement in the statutes or regulations that an application filed under 37 CFR § 1.53 include sequentially numbered pages, or all of the pages, or all of the drawings referred to in the specification to obtain a filing date.

34. The Proposed Filing Date Notice (at 60 FR 56984) stated that due to the effect that a loss of filing date can have on an application, the USPTO generally treats untimely filing date petitions on their merits since the application, as incomplete, will have undergone no further processing or examination.
35. The new missing page procedure (set forth in Section 601.01(d)) of the MPEP from July 1996 to the present) is that any application filed under 37 CFR § 1.53 without all the pages of the specification (e.g., with page numbering revealing that page(s) are missing) is treated as prima facie complete and is accorded a filing date. The USPTO continues to review application papers to determine whether all of the pages of the specification are present in the application. If the application is filed without all of the page(s) of the specification, but containing something that can be construed as a written description, at least one drawing figure, if necessary under 35 U.S.C. § 113, the names of all the inventors, and, in a nonprovisional application, at least one claim, the USPTO will mail a "Notice of Omitted Items" indicating that the application papers so deposited have been accorded a filing date, but are lacking some page(s) of the specification. The mailing of a "Notice of Omitted Items" will



permit the applicant to either: (1) promptly establish prior receipt in the USPTO of the page(s) at issue (generally by way of a date-stamped postcard receipt (MPEP § 503)), or (2) promptly submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the page(s) was in fact deposited in the USPTO with the application papers must file a petition under 37 CFR § 1.53(c) (and the petition fee under 37 CFR § 1.17(i), which will be refunded if it is determined that the page(s) was in fact received by the USPTO with the application papers deposited on filing) with evidence of such deposit within two months of the date of the "Notice of Omitted Items." An applicant desiring to submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted page(s) with an oath or declaration in compliance with 37 CFR §§ 1.63 and 1.64 referring to such page(s) and a petition under 37 CFR § 1.182 requesting the later filing date within two months of the date of the "Notice of Omitted Items." An applicant willing to accept the application as deposited in the USPTO need not respond to the "Notice of Omitted Items," and the failure to file a petition under 37 CFR § 1.53(c) or § 1.182 as discussed above within two months of the date of the "Notice of Omitted Items" will be treated as constructive acceptance by the applicant of the application as deposited in the USPTO. Amendment of the specification is required in a nonprovisional application to renumber the pages consecutively and cancel any incomplete sentences caused by the absence of the omitted pages.

36. The Implemented Filing Date Notice (at 61 FR 30045) stated that the adopted procedure replaces formalistic procedures with procedures based upon the requirements for a filing date as set forth in 35 U.S.C. §§ 111, 112, and 113.

**Opinion Regarding Filing Date**

37. It is my opinion that that the '955 application filed under 37 C.F.R. § 1.53 is entitled to a filing date of August 31, 1993 under the statutes and regulations in effect at that time. 35 U.S.C. § 111(a)(4) provided that "[t]he filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office." 37 CFR § 1.53(b) provided that "[t]he filing date of an application for patent filed under this section is the date on which: (1) a specification containing a description pursuant to 37 CFR § 1.71 and at least one claim pursuant to 37 CFR § 1.75; and (2) any drawing required by 37 CFR § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by 37 CFR § 1.41. The USPTO received 20 pages of drawings and 68 pages of specification including the claims. The 68 pages of specification consisted of an unnumbered title page followed by 67 pages numbered 2-68. The 68 pages of specification contained a description pursuant to 37 CFR § 1.71 and at least one claim pursuant to 37 CFR § 1.75. The 20 pages of drawings contained the drawings required by 37 CFR § 1.81(a). The unnumbered title page set forth the names of the actual inventors as required by 37 CFR § 1.41. As such, all the requirements for a filing date were met by the '955 application as deposited in the USPTO on August 31, 1993. Therefore, it is my opinion that that the '955

application filed under 37 C.F.R. § 1.53 is entitled to a filing date of August 31, 1993 under the statutes and regulations in effect at that time.

38. At the time the '955 application was filed there was no requirement that the first page of the specification be numbered and it was common for a first page of a document to be unnumbered even when the subsequent pages were numbered. In addition, 37 CFR §§ 1.72(a) and 1.77 together permit the title of the invention to appear as a heading on the first page of the specification, if it does not otherwise appear at the beginning of the application and that such title page may also state the name, citizenship, and residence of the applicant. Since a title page is considered to be part of the specification, it is my opinion that the '955 application as filed on August 31, 1993 was not prima facie incomplete by omitting a page numbered 1. While page numbered 2 started in mid-sentence, this is a minor error correctable by a suitable amendment to that page. Thus, it is my opinion that the '955 application was not "prima facie" incomplete and should not have been subjected to the old missing page procedure set forth in MPEP 608.01. It is my opinion that that the '955 application filed under 37 C.F.R. § 1.53 is entitled to a filing date of August 31, 1993 under the statutes, regulations and procedures in effect at that time.
39. To the extent that one believes the '955 application filed under 37 C.F.R. § 1.53 was not entitled to a filing date of August 31, 1993 for being incomplete by omitting a page numbered 1 and page numbered 2 starting in mid-sentence, then the old missing page procedure would be in effect. It is my opinion that the petition under 37 C.F.R. §§ 1.53 and 1.182 in the '955 application for a filing date of August 31, 1993 was grantable since the requirements of the old missing page procedure were

complied with. In that regard, the petition under 37 C.F.R. §§ 1.53 and 1.182 included a statement that missing page 1 was not necessary for an understanding of the subject matter sought to be patented and was accompanied by the \$130 petition fee (37 CFR § 1.17(h)) and an amendment canceling from the specification all incomplete sentences and renumbering the pages present in consecutive order. The petition noted that no claims depended upon missing page 1 for disclosure and support. The sole reason the USPTO dismissed the petition under 37 C.F.R. §§ 1.53 and 1.182 was because a declaration from the inventors stating their intention to rely on the application without page 1 was not included with the petition. MPEP 608.01 clearly provides that if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by the applicant stating that the invention is adequately disclosed in, and desire to rely on, the application as thus amended for purposes of an original disclosure and filing date. MPEP 608.01 then proceeds to provide that if the oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, **when filed**, must include a specific reference to the amendment cancelling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support. Since the applicant in the '955 application had not filed an oath or declaration for the application prior to the date of the petition under 37 C.F.R. §§ 1.53 and 1.182 and the accompanying amendment, it is my opinion that the petition under 37 C.F.R. §§ 1.53 and 1.182 in the '955 application for a filing date of August 31, 1993 should have been granted. In addition to granting a filing date of

August 31, 1993 the petition decision should have set a time period for response for applicant to pay the appropriate filing fees, to file an oath or declaration including a specific reference to the amendment filed October 29, 1993 (i.e., an oath or declaration by the inventors including a statement that their invention is adequately disclosed in, and their wish to rely on, the application as amended on October 29, 1993, without page 1 of the specification for purposes of an original disclosure and filing date) and to pay the surcharge as set forth in 37 C.F.R. § 1.16(e) as provided by 37 C.F.R. § 1.53(d). Thus, it is my opinion that that the '955 application filed under 37 C.F.R. § 1.53 is entitled to a filing date of August 31, 1993 under the statutes, regulations and procedures in effect at that time.

40. It is my opinion that the declaration by the applicants submitted in the '985 application in support of the 37 C.F.R. § 1.182 petition in the '985 application would be sufficient to correct any deficiency in the 37 C.F.R. §§ 1.53 and 1.182 petition in the '955 application that was pointed out by the February 20, 1994 dismissal of that petition. Thus, it could be viewed that the September 15, 1995 grant of the petitions in the '985 application, sub silentio, granted relief in the underlying '955 application.

#### **Opinion Regarding Fees and Priority**

41. It is my opinion that the fee language set forth in the February 28, 1994 extension of time filed in the '955 application was sufficient authorization to charge the processing and retention fee as then provided by 37 C.F.R. § 1.21(l). This extension of time included the following fee authorizing language "the

Commissioner is authorized to charge any fee or additional amounts due in connection with this communication to Deposit Account No. 04-1073." The extension of time further included in the heading thereof the fact that this extension was being requested to provide continuity to the 37 C.F.R. § 1.53 (Rule 53) continuation application being filed that day. As such, it is clear that a processing and retention fee was due so that continuity under 35 U.S.C. § 120 from the parent application (i.e., the '955 application) to the '985 continuation application would be appropriate. While 37 CFR § 1.22(b) provided that all patent fees paid to the USPTO **should be** itemized in each individual application in such a manner that it is clear for which purpose the fees are paid, 37 CFR § 1.22(b) does not require such itemization. The practice of the USPTO was to charge any fee required by a paper filed in an application to a Deposit Account if there was a general authorization to do so. The practice of the USPTO did not require an itemization in order to charge a fee to a Deposit Account. For example, a claim amendment requiring additional claim fees would have the needed claim fees charged to a Deposit Account if there was a general authorization to charge any fee due to the Deposit Account. Therefore, it is my opinion that the fee language set forth in the February 28, 1994 extension of time filed in the '955 application was sufficient authorization to charge the processing and retention fee as then provided by 37 C.F.R. § 1.21(l).

42. As set forth above, it is my opinion that that the '955 application filed under 37 C.F.R. § 1.53 is entitled to a filing date of August 31, 1993 under the statutes, regulations and procedures in effect at that time. It is my further opinion that a time period for applicant to pay the appropriate filing fees, to file an appropriate oath or

declaration and to pay the surcharge as set forth in 37 C.F.R. § 1.16(e) as provided by 37 C.F.R. § 1.53(d) has never been set in the '955 application. In that regard, as noted earlier, the September 14, 1993 Notice to File Missing Parts – No Filing Date did not set a specific time period for paying the appropriate filing fees, filing an appropriate oath or declaration and to pay the surcharge as set forth in 37 C.F.R. § 1.16(e). The missing parts practice when a filing date petition was granted was to either (1) set an extendible period for response to file the missing parts and surcharge in the granted filing date decision, or (2) to return the file to Application Branch for the mailing of a Notice to File Missing Parts of Application - Filing Date Granted, setting an extendible period for filing the missing parts and surcharge. Accordingly, it is my opinion that the '955 application is still pending.

43. Since the '955 application is still pending with a filing date of August 31, 1993 for the reasons set forth above, it is possible for applicant to timely pay the basic filing fee due in this application and to amend the specification to contain a specific reference to the earlier filed '917 application which can be relied upon for priority as provided by 35 U.S.C. § 120 and 37 CFR § 1.78(a). In addition, since the '955 application is pending it can be relied upon for priority as provided by 35 U.S.C. § 120 and 37 CFR § 1.78(a) in the '985 application.

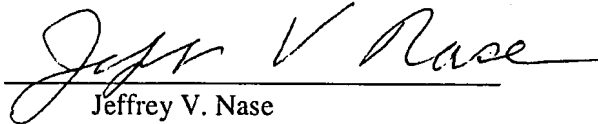
#### **Summary of Opinion Formed**

44. For the reasons set forth above, it is my opinion that Application No. 08/113,955 is entitled to a filing date of August 31, 1993 and the '955 application can be relied

upon for priority under 35 U.S.C. § 120 and 37 CFR § 1.78(a) from the '985 application to the '917 application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

May 4, 2009  
Date

  
Jeffrey V. Nase





HERSHKOVITZ & ASSOCIATES, LLC  
2845 DUKE STREET  
ALEXANDRIA, VA 22314  
703-370-4800

In re patent of : Michael Reed et al. Docket No.: E4800.0020/P001-B  
Application No. : 08/113,955 Examiner : David Bucci  
Rexam Request filed : August 31, 1993 Confirmation No.: 3543  
For : MULTIMEDIA SEARCH SYSTEM

COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Transmitted herewith are a **REQUEST FOR RECONSIDERATION/PETITION FOR SUPERVISORY REVIEW OF DECISION DENYING PETITION FOR A FILING DATE** and a **DECLARATION IN SUPPORT OF REQUEST FOR RECONSIDERATION OF DECISION DENYING PETITION FOR A FILING DATE IN APPLICATION NO. 08/113,955** in the above-captioned application.

The fee has been calculated as shown below:

Claims After Amendment	No. of Claims Previously Paid	Present Extra	Small Entity		Large Entity	
			Rate	Fee	Rate	Fee
Total Claims:			x 25=	\$	x 50=	\$
Independ. Claims:			x 105=	\$	x 210=	\$
Multiple Dependent Claims Presented			+185=	\$	+375=	\$
Petition under 37 C.F.R. 1.182, fee under 1.17(f)				\$	400	\$
Total:				\$	Total:	\$

☐ Please charge my Deposit Account No. **50-2929** in the amount of \$ .

☐ Fee Authorization given through EFS-Web form.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. **50-2929**:

☐ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).

May 4, 2009

Date

J8300.1.A07; AH/dj

Abraham HersHKovitz

Reg. No. 45,294

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	5274121
<b>Application Number:</b>	08113955
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	3543
<b>Title of Invention:</b>	?
<b>First Named Inventor/Applicant Name:</b>	MICHAEL REED
<b>Customer Number:</b>	24998
<b>Filer:</b>	Abraham HersHKovitz
<b>Filer Authorized By:</b>	
<b>Attorney Docket Number:</b>	E4800.001P00
<b>Receipt Date:</b>	04-MAY-2009
<b>Filing Date:</b>	31-AUG-1993
<b>Time Stamp:</b>	19:56:49
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Miscellaneous Incoming Letter	J8300-1_A06_Transmittal.pdf	45162 98d2da4786e82861e277a2039ee7a551a56d2500	no	1

### Warnings:

### Information:

2	Petition for review by the Office of Petitions.	J8300-1_A06_Req-Rcnsdrth-Pet-for-Suprvsry-Revw-of-Decsn-Dnyg-Pet-for-Filing-Date.pdf	1442438 bc2802738f07e06f33af8658408de406c381328c	no	26
<b>Warnings:</b>					
<b>Information:</b>					
3	Petition for review by the Office of Petitions.	J8300-1_NASE_Declaration.pdf	919328 b005a88243e41b62a00f57b0ba863940ec1f98	no	22
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>			2406928		
<p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><b><u>New Applications Under 35 U.S.C. 111</u></b>  If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><b><u>National Stage of an International Application under 35 U.S.C. 371</u></b>  If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><b><u>New International Application Filed with the USPTO as a Receiving Office</u></b>  If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p>					